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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,806	10/03/2003	Kevin Goldsmith	MS1-1707US	3250
22971	7590	05/23/2007	EXAMINER	
MICROSOFT CORPORATION ONE MICROSOFT WAY REDMOND, WA 98052-6399			HASSAN, RASHEDUL	
			ART UNIT	PAPER NUMBER
			2179	
			NOTIFICATION DATE	DELIVERY MODE
			05/23/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/678,806	Applicant(s) GOLDSMITH, KEVIN	
	Examiner Rashedul Hassan	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 32-34 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application |
| 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) ☐ Other: ____ |

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "912" has been used to designate both random access memory (RAM) and read only memory (ROM). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The "modal" of claim 10 lacks antecedent basis in the specification.

Claim Objections

Applicant is advised that should claim 24 be found allowable, claim 32 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof (see the rejection under 35 U.S.C 112, second paragraph hereinafter). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected as being directed to non-statutory subject matter.

Claims 1-13 are directed to a system. However, the system as claimed can reasonably be interpreted as nothing more than programs or functional descriptive materials only, without any expressed combination with an appropriate computer readable medium so as to be structurally and functionally interrelated to the medium and permit the functionality of the descriptive material to be realized. As such, these claims are rejected for being directed to non-statutory subject matter under the

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meaning of 35 U.S.C 101.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 depends from cancelled claim 31. As such it is rejected under 35 U.S.C 112, second paragraph, as being indefinite. Based on applicant's remark of 03/06/2007, claim 32 has been considered to be dependent from claim 22 for further examination and as such, considered to be a duplicate of claim 24.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9,11-30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasuhiro Suzuki (US 5,485,175) hereinafter Yasuhiro.

For claim 1, Yasuhiro teaches a computer implemented method and corresponding system comprising:

One or more applications (circuit designing CAD application, column 1 line 21-24); and

An operating system (inherent in a work station as mentioned in column 1 line 18) having at least one module (operating system routines that must be invoked using system calls from applications requesting service from the operating system for various low-level functions such as reading from an input device, writing to a display device, memory management etc.) configured to receive menu calls (menu calls in the broadest reasonable interpretation can be considered to be system calls made with regard to menuing tasks) from the one or more applications and to service those calls by:

displaying (a system call must be made to invoke operating system routines in order to access the display device for displaying) a top level menu (menu 3A in Fig. 2A);

receiving (a system call must be made to invoke operating system routines in order to receive a selection using an input device) a first selection of the top level menu item (menu item B of top level menu 3A in Fig. 2A);

in response to the first selection, displaying (a system call must be made

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to invoke operating system routines in order to access the display device for displaying) a second level menu (3B in Fig. 2A) in place of the top level menu (Column 4, line 38-42), the second level menu including the top level menu item (6 in menu 3B in Fig. 2A) and second level menu items (4 in menu 3B in Fig. 2A).

Hereinafter all limitations concerning the tasks of "displaying" or receiving a selection are considered to be inherently taught by Yasuhiro as being serviced, at least in part (at the lower level), by operating system routines (modules) based on the above reasoning presented in the rejection of claim 1, even if not explicitly pointed out by the examiner in this Office Action.

For claims 2, 4 and 5 Yasuhiro further teaches that the at least one module (operating system routines as described in the rejection of claim 1 hereinabove) is further configured for displaying a senior level menu in place of (column 4, lines 38-42) a junior level menu when the respective senior level menu item is selected from the junior level menu. Yasuhiro uses a senior branching line for reversing the menu hierarchy (Fig 2B, Column 5, lines 43-52).

For claim 3, Yasuhiro further teaches that the at least one module (operating system routines as described in the rejection of claim 1 hereinbefore) is further configured for:

receiving a second selection of a second level menu item (B3 of second level

menu 3B in Fig. 2A);

in response to the second selection, displaying a third level menu (3C in Fig. 2A) in place of the second level menu (3B in Fig. 2A), the third level menu including the top level menu item (B in third level menu 3C in Fig. 2A), the second level menu item (B₃ in third level menu 3C in Fig. 2A) and third level menu items (4 in third level menu 3C in Fig. 2A) when a second level menu item (B₃ in second level menu 3B in Fig. 2A) is selected from the second level menu.

For claim 6, Yasuhiro further teaches that the menu displayed in a particular hierarchy each displayed with at least an identical hierarchy "command name displaying part" , a "junior hierarchy branching mark displaying part" and a "senior command name displaying part" (summary of the invention). Thus anticipating the claimed limitations:

the at least one module (operating system routines as described in the rejection of claim 1 hereinbefore) configured for:

receiving a third selection of a third level menu item from the third level menu;
and

in response to the third selection, displaying a fourth level menu in place of the third level menu, the fourth level menu including all the selected items from parent menus (senior command name displaying part) and also fourth level menu items (command name displaying part) when a third level menu item is selected from the third level menu.

For claim 7, Yasuhiro further teaches that the top level menu item (B in second level menu 3B in Fig. 2A) is oriented within the second level menu (3B in Fig. 2A) above the second level menu items (4 in second level menu 3B in Fig. 2A).

For claims 8,11 and13, Yasuhiro anticipates the claimed limitations of associating a "backward pointer" (senior hierarchy branching mark) with the upper level menu item(s) (senior hierarchy command name displaying part) to indicate that a selection of one of the upper level menu items will replace the current level menu with the respective upper level menu (Column 4, line 50-59, 3B in Fig. 2A).

For claims 9 and 12, Yasuhiro anticipates the claimed limitations of associating a "forward pointer" (junior hierarchy branching mark) with the current level menu items (identical hierarchy command name displaying part) in the current level menu to indicate that a selection of a current level menu item will replace the current level menu with a lower level menu (column 4, lines 6-12, 3B in Fig. 2A).

For claim 14, Yasuhiro teaches a computer including the system of claim 1 (column 1 line 18).

For claims 15-16 Yasuhiro teaches a computer (column 1 line 18) comprising:

One or more applications (circuit designing CAD application, column 1 line 21-24); and

at least one module configured to service calls (operating system routines that must be invoked using system calls from applications requesting service from the operating system for various low-level functions such as reading from an input device, writing to a display device, memory management etc.,) received via one or more application programming interfaces (inherent since application programming interface is the interface by which an application program accesses operating system to request services) from the one or more applications by:

displaying (a system call must be made to invoke operating system routines in order to access the display device for displaying) a parent menu (3A in Fig. 2A);

displaying a submenu (3B in Fig. 2A) in place of the parent menu in response to a selection of a parent menu item (menu item B in parent menu 3A in Fig. 2A, column 4, line 38-42) within the parent menu; and maintaining a stack of previously selected parent menu items (6 in 3B in Fig. 2A, low-level operating system routines inherently service memory access and management functions for maintaining the stack in memory and for subsequently displaying the stack on the display) in the submenu (3B), each of previously selected menu items (menu item B in 3B in Fig. 2A) configured to display a corresponding parent menu in place of the submenu when selected (Column 5, lines 43-52).

For claims 17, Yasuhiro teaches a tangible processor-readable medium

(inherently taught in Yasuhiro as being a necessary requirement to store the instructions for carrying out the described method) comprising processor-executable instructions that are configured to provide at least one module (operating system routines as pointed out in the rejection of claim 15 hereinbefore) that is callable by one or more applications (CAD application, column 1 lines 21-24) via one or more application programming interfaces (inherent as pointed out in the rejection of claim 15 hereinbefore) for:

- displaying (a system call must be made to invoke operating system routines in order to access the display) a parent menu from a hierarchical menu (3A in Fig. 2A);

- receiving (a system call must be made to invoke operating system routines in order to receive a selection using an input device) a first selection of a menu item from the parent menu (menu item B of the parent menu 3A in Fig. 2A);

- displaying (a system call must be made to invoke operating system routines in order to access the display device for displaying) a submenu (3B in Fig. 2A) from the hierarchical menu in place of the parent menu in response to the first selection (Column 4, line 38-42); and

- displaying the menu item (B in menu 3B in Fig. 2A) within the submenu as a previously selected menu item selectable to jump back to the parent menu.

For claim 19, Yasuhiro further teaches that the module is further callable to display (a system call must be made to invoke operating system routines in order to access the display device for display) a second submenu (3C in Fig. 2A) from the hierarchical menu in place of the submenu (3B in Fig. 2A) in response to receipt of a

selection of a submenu item, wherein the second submenu (3C in Fig. 2A) includes the previously selected menu item (B in menu 3C in Fig. 2A) selectable to jump back to the parent menu and the submenu item (B3 in menu 3C in Fig. 2A) selectable to jump back to the submenu (Column 5, lines 43-52).

Claims 20-23 and 25-30 are directed to a tangible processor-readable medium comprising processor-executable instructions that are configured to provide at least one module that is callable by one or more applications to display a GUI configured to implement a hierarchical menu or to display a hierarchical menu wherein the hierarchical menu has some of the limitations as already recited in previous claims. Since a menu displayed on a computer screen is by necessity a GUI (graphical user interface), and since these claims do not recite any additional limitations that have not been already addressed in the rejections of claims 1-19 hereinabove, Yasuhiro anticipates these claims also based on the same reasoning as discussed in detail regarding claims 1-19 hereinabove.

Claims 24 and 32 are directed to a computer comprising the tangible processor readable medium that is configured to provide the at least one module that is callable by the one or more applications to display the GUI of claim 22. Since the use of a computer is taught by Yasuhiro (column 1 line 18) and since all the limitations of the GUI of claim 22 are anticipated by Yasuhiro as explained in the foregoing discussion, these claims are therefore also anticipated by Yasuhiro.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuhiro in view of Jobs et al. (US 6,686,938 B1) hereinafter Jobs.

For claim 33, Yasuhiro teaches a computer (column 1 line 18) comprising:
an application program (circuit designing CAD application, column 1 line 21-24);
a hierarchical in-place menu (Fig. 2A) including a parent menu (3A in Fig. 2A) and a submenu (3B in Fig. 2A) each displayable separately from one another (column 4, line 38-42) and each having a parent menu option (B in menu 3A and 3B in Fig. 2A), the parent menu option selectable from the parent menu to replace the parent menu with the submenu (column 4, line 38-42) and the parent menu option selectable from the submenu to replace the submenu with the parent menu (column 5, lines 43-55).

Although Yasuhiro teaches implementing the hierarchical menu as an in-place pop-up menu within a circuit design CAD program (hence, the CAD program as a whole can be considered as a hierarchical in-place menu module), nevertheless, Yasuhiro

does not explicitly teach encapsulating the menu functionality within a procedure or a function or a class etc., so as to be considered as a separate module from the code segment of the application program. Therefore, he also does not explicitly teach calling such a module via one or more application programming interfaces that would have been inherent if the menu functionality were encapsulated within a procedure or a function or a class etc.

However, Jobs teaches providing commonly used menu functionalities in the form of a module, a menu toolbar, directly from an operating system as an operating system extension (column 8, lines 31-40). Since the menu toolbar is implemented as an object (module), and furthermore, as an extension to the operating system, it by necessity must provide one or more application programming interfaces so as to enable other applications to request its' services.

Therefore, it would have been obvious for a person of ordinary skill in the art at the time of the invention to combine the teaching of Jobs with that of Yasuhiro to implement the hierarchical in-place menu as an extension module to the operating system to arrive at the present invention. The motivation for the combination would have been to provide an operating system based hierarchical in-place menu for providing universally available functions for many applications (Jobs, column 8 lines 45-48).

For claim 34, Yasuhiro teaches that the application program is configured to request that the operating system implement a hierarchical menu as a hierarchical in-place menu (since Yasuhiro teaches implementing a hierarchical menu as a hierarchical

in-place menu using the low-level services provided by the operating system based upon requests from the application programs).

The limitation "an operating system including the hierarchical in-place menu module" can be interpreted to have at least two different interpretation based on the meaning of the word "including" recited in the claim. According to "American Heritage Dictionary" the word "include" can have the following three meanings:

- i) to take in as a part, element, or member.
- ii) to contain as a secondary or subordinate element.
- iii) to consider with or place into a group, class, or total.

Dictionary.com Unabridged (v 1.1) further provides a slightly different meaning of the word include as:

- iv) to contain, as a whole does parts or any part or element.

Therefore, as constructed the limitation can reasonably be interpreted, at least in light of the third meaning cited above, to claim a computer comprising a group of software, such as an operating system and the hierarchical in-place menu module. According to this interpretation the claim was rejected under 35 U.S.C. 102(b) in the Office Action of 11/06/2006 since Yasuhiro inherently anticipates this limitation as he explicitly teaches a workstation (computer) with the hierarchical in-place menu module and an operating system being inherent in a workstation. The applicant did not refute the previous rejection made in the Office Action of 11/06/2007 in the applicant's remarks of 03/06/2007. Therefore, it seems that the applicant acquiesce to the rejection. Since applicant's amendment to this claim still does not exclude this interpretation, Yasuhiro

still teaches this limitation of the claim. However, due to applicant's amendment to the independent claim 33 from which this claim depends, previous rejection under 35 U.S.C. 102(b) has been replaced by this rejection under 35 U.S.C. 103(a). On the other hand, if the limitation is interpreted, at least in light of the fourth meaning cited above, to claim a computer comprising an operating system, wherein the operating system includes the hierarchical in-place menu module, Yasuhiro fails to teach such limitation. However, as discussed in the rejection of the independent claim 33, Jobs teaches this limitation (MenuTools being the extension of the operating system) and therefore the claim being obvious in view of Jobs for the reasoning and motivation already mentioned in the rejection of claim 33 above.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuhiro in view of Cohen.

For claim 10, Yasuhiro discloses all the limitations of the top level menu and the second level menu except for both being "modal" menus. However, displaying a window or menu in either a modal or a non-modal state was a common practice in the art at the time of the invention as disclosed by Cohen. According to Cohen, three words embody the visual-interface style: responsiveness, permissiveness and consistency. Permissiveness allows the user to do anything reasonable. Menu-driven applications represent the opposite of permissive applications because they present a preset number of selections, which leads the user down a very definite path toward the

performance of a function (page 2, line 15-18). Therefore, although Yasuhiro's menu is not intended to function as a modal menu, it would have been obvious given the general knowledge in the art at the time of the invention for a person of ordinary skill in the art to create Yasuhiro's menu as modal menu for the motivation as described by Cohen, which is to present a preset number of selections, which leads the user down a very definite path toward the performance of a function.

Response to Arguments

Applicant's arguments filed on 03/06/2007 have been fully considered but they are not persuasive.

Applicant failed to respond to the objections to both the drawings and the specification made in the Office Action of 11/06/2006. Same objections have been made in this Office Action.

The rejections under 35 U.S.C. 101 for claims 15,16 and 20-31 made in the Office Action of 11/06/2006, are hereby withdrawn in consideration of applicant's amendments.

Claims 31 and 35-37 are cancelled by the applicant.

Applicant failed to argue to the rejections under 35 U.S.C. 102(b) for claims 33 and 34 made in the Office Action of 11/06/2006. Nevertheless, the previous rejections for claims 33 and 34 are hereby withdrawn in consideration of, and as necessitated by applicant's amendment to the independent claim 33. However, claims 33 and 34 are rejected in this Office Action based on new ground(s) of rejection as necessitated by the

amendments as discussed in detail hereinbefore.

The rejections under 35 U.S.C. 102(b) for claims 1-9, 11-30 and 32 and the rejection under 35 U.S.C. 103(a) for claim 10 made in the Office Action of 11/06/2006 stands. Applicant argued that the asserted references, alone or in combination, do not disclose, teach or suggest the features added to these claims by the amendments. However, the applicant's argument was not persuasive since the added limitations are taught by the asserted reference (Yasuhiro) as discussed in detail in this Office Action hereinbefore.

Telephone inquiry

The examiner returned a call from the applicant on March 1st, 2007 inquiring whether the applicant wishes to schedule an interview with the examiner. The applicant did not request an interview at that time and no telephone interview was performed on that date. The examiner did not discuss with the applicant on the merits of the case. The applicant stated the asserted reference (Yasuhiro) to be highly relevant and requested the examiner to consider the submitted amendment. The examiner agreed to consider the amendment in due course, but did not commit to call back the applicant as alleged in "Applicant summary of Interview with examiner" filed on 03/06/2007. Applicant's amendments and arguments filed on 03/06/2007 have now been fully considered and the decision of the examiner is made of record in this Office Action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

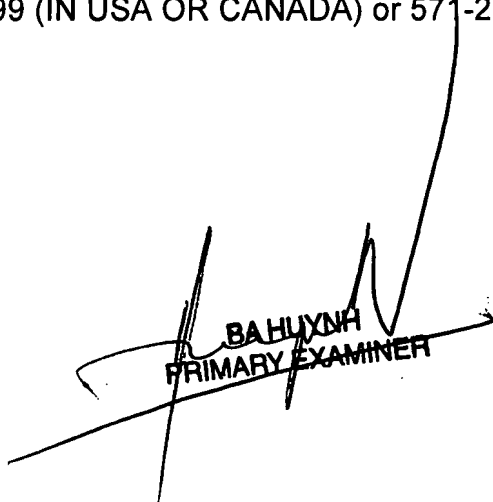
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rashedul Hassan whose telephone number is 571-272-9481. The examiner can normally be reached on M-F 7:30AM - 4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



(Rashedul Hassan)



BAHUYNH
PRIMARY EXAMINER